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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,773	06/25/2003	Nobutsuna Motohashi	K06-158963M/TBS	2246

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EXAMINER

JIMENEZ, MARC QUEMUEL

ART UNIT PAPER NUMBER

3726

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/602,773

Applicant(s)

MOTOHASHI, NOBUTSUNA

Examiner

Marc Jimenez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claims 1 and 3-15** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation “alternatively repeating the first pressing and the second pressing a plurality of times” in claim 1, line 13-14 and in claim 3, line 12 is new matter. There is no support in the original disclosure for the “alternatively repeating” step now claimed. Applicant states in the response filed on 9/14/04 that page 13, lines 4-10 has support for this limitation. However, there is no mention of “alternatively repeating”. On page 13, lines 4-10, it is stated that machining is “... repeatedly conducted by a plurality of times...”.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. **Claim 8** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 recites “using a second die” in line 2. However, there is no “first die” recited in claim 1. Therefore, this limitation is unclear.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 1, 3-5, and 7-15** are rejected under 35 U.S.C. 102(b) as being anticipated by Yoshio (JP 2001-191139).

Yoshio teaches a method of manufacturing a rocker arm for opening and closing a valve (figure 14) including providing a metallic sheet **20A** (figure 1), bending the metallic sheet **20A** to form a pair of predetermined side wall regions **22** and a predetermined connecting wall region **30** for connecting the pair of predetermined side wall regions **22**, first pressing outer sides (figure 4) of the pair of predetermined side wall regions in a connecting direction in which the predetermined connecting wall region **30** extends, respectively, to plastically flow so that a height of the pair of predetermined side wall regions is gradually increased (figure 4), second pressing (figure 5) the predetermined connecting wall region **30** so as to be recessed **42** in a

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height direction perpendicular to the connecting direction, wherein a metal flow continues between the valve guide walls including distal ends thereof and the connecting wall. The limitation “alternatively repeating” is read to mean that all of the steps after the word “alternatively” could be performed or does not have to be performed. Therefore, Yoshio teaches the invention as claimed.

Regarding claim 3, note the punching of the sheet **20A** to form the side wall regions and the connecting wall region (see figure 2).

Regarding claim 4, note the opening **26**.

Regarding claim 5, note the second connecting wall **23** with a hemispherical pivot receiving portion **24**.

Regarding claims 7-9 and 12, note the dies used to form the side wall regions (see figure 4) and the connecting wall **40** (see figure 5) which is curved.

Regarding claim 10, note the side wall region is pressed toward the center of the rocker arm such that a thickness of the connection wall region is increased (see figures 4 and 7).

Regarding claim 11, note the side wall regions plastically flowing and increasing in height (figure 4-6).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claim 6** is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshio in view of Ohsaki et al. (4,969,957).

Yoshio teaches the invention cited with the exception of softening annealing the rocker arm.

Ohsaki et al. teach annealing a rocker arm (col. 8, lines 34-37).

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Ohsaki et al. with annealing, in light of the teachings of Yoshio, in order to strengthen the material of the rocker arm.

Response to Arguments

9. Applicant's arguments with respect to claims 1 and 3-15 have been considered but are moot in view of the new ground(s) of rejection.

10. In response to applicant's arguments that Yoshio does not teach that the first and second pressing functions are alternatively repeated a plurality of times, it is noted that "alternatively repeating" is read to mean that all of the steps after the word "alternatively" could be performed or does not have to be performed. Therefore, Yoshio meets this limitation. Furthermore, the limitation "alternatively repeating the first pressing and the second pressing a plurality of times" in claim 1, line 13-14 and in claim 3, line 12 is new matter. There is no support in the original disclosure for the "alternatively repeating" step now claimed. Applicant states in the response filed on 9/14/04 that page 13, lines 4-10 has support for this limitation. However, there is no

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mention of “alternatively repeating”. On page 13, lines 4-10, it is stated that machining is “... repeatedly conducted by a plurality of times...”.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Interviews After Final

12. Applicant note that an interview after a final rejection will not be granted unless the intended purpose and content of the interview is presented briefly, in writing (the agenda of the interview must be in writing) to clarify issues for appeal requiring only nominal further consideration. Interviews merely to restate arguments of record or to discuss new limitations will be denied. See MPEP 714.13 and 713.09.

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Contact Information

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number (571) 272-4530. The examiner can normally be reached on Monday-Friday between 5:30 a.m.-2:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 273-4530. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


MS

November 30, 2004



**DAVID P. BRYANT
PRIMARY EXAMINER**